

REMARKS

In the Office Action, the Examiner rejected claims 1, 7, and 19 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement; rejected claims 1-3, 5, 7, and 9-19 under 35 U.S.C. § 103(a) as being unpatentable over Unno (U.S. Patent No. 6, 437, 875) in view of Nakai et al. (U.S. Patent No. 5, 946, 457); rejected claims 4 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Unno and Nakai et al. and further in view of Okamura et al. (U.S. Patent No. 6,266,162); and rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Unno and Nakai et al. and further in view of Mori et al. (U.S. Patent No. 6,292,267). Based on the following reasoning, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 112 and § 103(a).

I. The Rejection of Claims 1, 7, and 19 Under 35 U.S.C. § 112).

Regarding the rejection of claims 1, 7, and 19 under 35 U.S.C. § 112, 1st paragraph, Applicants respectfully traverse the Examiner's statement that "[t]he claims seem to teach" a specific function. Applicants submit that the claims define the invention. Nonetheless, to expedite prosecution, Applicants have amended claims 1 and 19 to recite "transmitting means for periodically reading from the storage means to determine if the information relating to the document image is stored in the storage means." A corresponding amendment has been made to method claim 19. Applicants submit that the specification clearly describes all claimed subject matter in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See Applicants' specification at, for example, page 47, lines 1-24 of the present

application. Therefore, Applicants request the Examiner to withdraw the rejections of claims 1, 7, and 19 under 35 U.S.C. § 112, 1st paragraph, and allow the claims.

II. The Rejection of Claims 1-3, 5, 7, and 9-19 Under 35 U.S.C. § 103).

Claims 1-3, 5, 7, and 9-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Unno in view of Nakai et al. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Claim 1 recites "[a] document input system," including *inter alia* "transmitting means for periodically reading from the storage means to determine if the information relating to the document image is stored in the storage means and, if so, transmitting the document image corresponding to the read out information to one of the at least one system based on the read out information relating to the document image." Unno fails to teach at least this limitation. The Examiner has characterized the receiving device of Unno as constituting the claimed storage means, Even if this characterization were correct, Unno fails to teach a "transmitting means" that periodically reads from the receiving device, as

recited in claim 1. In fact, in Unno, there is no reading of any data (singly or periodically) by the way of a transmitting means. Unno teaches that data is only outputted to clients. Therefore, Unno fails to teach or suggest “transmitting means for periodically reading from the storage means to determine if the information relating to the document image is stored in the storage means and if so, transmitting the document . . .,” as recited in claim 1.

Further, Unno also fails to teach “transmitting means for periodically reading from the storage means to determine if the information relating to the document image is stored in the storage means . . .,” as recited in claim 1. Unno discloses “[i]n the case where a destination server is a server capable of communicating via the SLM . . . image data (two-level image data) obtained via a scanner is compressed . . . and converted to TIFF . . . The resulting image data is stored in a particular folder of the server.” Col. 14, lines 12-20. Unno teaches similar functionality in the case of where a destination is an e-mail server. Col. 14, lines 30-39. That is, Unno teaches the storage of a document image but fails to teach the storage of “information relating to the document image,” as recited in claim 1.

Furthermore, Applicants submit that Nakai et al. does not cure this deficiency-- that is, Nakai et al. also does not disclose or suggest at least “transmitting means for periodically reading from the storage means to determine if the information relating to the document image is stored in the storage means and, if so, transmitting the document image corresponding to the read out information to one of the at least one system based on the read out information relating to the document image,” as recited in claim 1. More specifically, in response to the previous rejection of claims 1-3, 5, 7, 9, and 14-19, under Nakai et al. Applicants demonstrated in the paper filed on July 2, 2004, that Nakai et al. failed to disclose this same feature. The Examiner has admitted that these arguments

were persuasive. OA at 2. Applicants therefore submit that Nakai et al. cannot cure Unno's failure to disclose or suggest at least "transmitting means for periodically reading from the storage means to determine if the information relating to the document image is stored in the storage means and if so, transmitting the document image corresponding to the read out information to one of the at least one system based on the read out information relating to the document image," as recited in claim 1.

Since the cited references, taken either alone or in any reasonable combination, fail to teach each and every element required by claim 1, no prima facie case of obviousness has been made out with respect to this claim. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103 as being obvious from Unno in view of Nakai et al.

Claims 3, 5, 7, and 9-18 depend from claim 1. As explained, claim 1 recites elements not disclosed by Unno and Nakai et al. Accordingly, claims 3, 5, 7, and 9-18 are allowable over Unno and Nakai et al. for at least the same reasons as claim 1. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claim 19 although of different scope, recites elements similar to that discussed above with regard to claim 1. Applicants therefore request the Examiner to withdraw the rejection of claim 19 for at least the same reasons discussed above with respect to claim 1.

III. The Rejection of Claims 4 and 8 Under 35 U.S.C. § 103).

Claims 4 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Unno and Nakai et al. and further in view of Okamura et al. Applicants respectfully

traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness. Claims 4 and 8 depend from claim 1 and therefore include all the elements of claim 1. As explained, claim 1 recites elements not disclosed by Unno and Nakai et al.

Furthermore, Applicants submit that Okamura et al. does not cure this deficiency.

That is, Okamura et al. also fails to teach “transmitting means for periodically reading from the storage means to determine if the information relating to the document image is stored in the storage means and if so, transmitting the document image corresponding to the read out information to one of the at least one system based on the read out information relating to the document image,” as recited in claim 1. Indeed, the Examiner cited Okamura et al. only for its alleged teaching of “job history storage means for storing history of various jobs including an input document of the document image,” job history management means for . . . storing information indicating an occurrence of the error in the job history storage means,” and “occurrence of the error” at the digital copier.” OA at 10-11.

Since the cited references, taken either alone or in any reasonable combination, fail to teach each and every element required by claims 4 and 8, no *prima facie* case of obviousness has been made out with respect to this claim. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 4 and 8 under 35 U.S.C. § 103 as being obvious from Unno and Nakai et al. and further in view of Okamura et al.

IV. The Rejection of Claim 6 Under 35 U.S.C. § 103).

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Unno and Nakai et al. and further in view Mori et al. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

Claim 6 depends from claim 1 and therefore includes all the elements of claim 1. As explained, claim 1 recites elements not disclosed by Unno and Nakai et al.

Furthermore, Applicants submit that Mori et al. does not cure this deficiency. That is, Mori et al. also fails to teach “transmitting means for periodically reading from the storage means to determine if the information relating to the document image is stored in the storage means and if so, transmitting the document image corresponding to the read out information to one of the at least one system based on the read out information relating to the document image,” as recited in claim 1. Indeed, the Examiner cited Mori et al. only for its alleged teaching of “image input control means assign[ing] priorities to the information relating to the document image and generat[ing] title for the document image based on the priorities.” OA at 11.

Since the cited references, taken either alone or in any reasonable combination, fail to teach each and every element required by claim 6, no prima facie case of obviousness has been made out with respect to this claim. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claim 6 under 35 U.S.C. § 103 as being obvious from Unno and Nakai et al. and further in view of Mori et al.

V. Conclusion

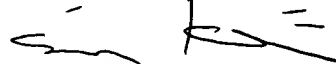
In view of the foregoing remarks, Applicants submit that this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, GARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 7, 2005

By: 
Milan Kapadia
Reg. No. 55,982